



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/996,565      | 11/30/2001  | Sophie Helene Vayrette | 05725.0998-00       | 3812             |

7590

03/08/2004

Thomas L. Irving  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.  
1300 I Street, N.W.  
Washington, DC 20005-3315

|          |
|----------|
| EXAMINER |
|----------|

BRUENJES, CHRISTOPHER P

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1772

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding:

|                              |   |  |  |
|------------------------------|---|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/996,565      | <b>Applicant(s)</b><br>VAYRETTE, SOPHIE HELENE |  |
|                              | <b>Examiner</b><br>Christopher P Bruenjes | <b>Art Unit</b><br>1772                        |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 39-49 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 39-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1772

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group I Claims 1-28 and 39-40 in the Paper filed January 9, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***REPEATED REJECTIONS***

2. The 35 U.S.C. 102 rejections of claims 1-3, 6, 7, 15, 18, 22, 23, 28, 39, and 40 as anticipated by Chono et al are repeated for the reasons previously of record in the Office Action mailed July 9, 2003, Pages 3-4 Paragraph 4.

3. The 35 U.S.C. 103 rejections of claims 4-5 and 24-25 over Chono et al are repeated for the reasons previously of record in the Office Action mailed July 9, 2003, Pages 4-5 Paragraph 5.

4. The 35 U.S.C. 103 rejections of claims 8-14 and 26-27 over Chono et al in view of Ovadia are repeated for the reasons previously of record in the Office Action mailed July 9, 2003, Pages 5-7 Paragraph 6.

5. The 35 U.S.C. 103 rejections of claims 19-21 over Chono et al are repeated for the reasons previously of record in the Office Action mailed July 9, 2003, Page 7 Paragraph 7.

6. The 35 U.S.C. 103 rejections of claims 16-17 over Chono et al are repeated for the reasons previously of record in the Office Action mailed July 9, 2003, Page 8 Paragraph 8.

***NEW REJECTIONS***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Chono et al (JP 08-050452).

Chono et al anticipate a box comprising a body formed from a blank that is precut with score lines and folded to form the body (p.13, paragraphs 24-25 of translation and Fig. 5). The blank comprises a support having a first surface and a second

Art Unit: 1772

surface, wherein the outer surface has printing thereon, and at least one sheet of non-woven material arranged on the outer surface by adhesive, in which the non-woven material is partially transparent so that the printing on the support is visible through the non-woven material (see abstract). The non-woven material is formed from thermoplastic fibers, such as polyester (see abstract). The second surface of the support is the inside surface of the box (reference number 18, Figure 5), and therefore inherently is substantially free from any adhesive, because otherwise the product stored in the box would be adhesively bonded to the inside of the box.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

Art Unit: 1772

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chono et al (JP 08-050452).

Chono et al anticipate a box comprising a body formed from a blank that is precut with score lines and folded to form the body (p.13, paragraphs 24-25 of translation and Fig. 5). The blank comprises a support having a first surface and a second surface, wherein the outer surface has printing thereon, and at least one sheet of non-woven material arranged on the outer surface by adhesive, in which the non-woven material is partially transparent so that the printing on the support is visible through the non-woven material (see abstract). The non-woven material is formed from thermoplastic fibers, such as polyester (see abstract).

Chono et al fail to teach adding a second layer exactly like the first layer of printing and non-woven material arranged by adhesive bonding to the outer surface of the box, also to the inner surface of the box, in order to provide aesthetic appeal

Art Unit: 1772

to the inner surface as well as the outer surface. One of ordinary skill in the art would have recognized that for the same reasons printing and a non-woven material are attached to the outer surface of the box, printing and a non-woven material would be added to in the inner surface of the box, especially for aesthetic appeal.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add printing and a non-woven material to the inner surface of the box, that performs the same purpose as the printing and non-woven material on the outer surface of the box, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments regarding the 35 U.S.C. 102 rejections as anticipated by Chono et al have been fully considered but they are not persuasive.

In response to Applicant's argument that Chono et al teaches a label applied to a box and not a blank for forming a box, although the main embodiment taught by Chono et al is for a label, Chono et al also teaches that in contrast to the label

Art Unit: 1772

the printed matter may also be an article for manufacturing packing containers such as the box shown in Figure 5 (p.13, paragraph 24 of translation). Chono et al further teaches that the printing is completed on the paper and non-woven material laminate on a packing container that is in a developing stage or intermediate stage. The intermediate stage for boxes such as the packing container 18 is a blank. Chono et al also states that the printing and formation of the laminate is completed before the laminate is punched and assembled in a prescribed shape, therefore describing forming the blank with printing before constructing the box (p.13, paragraph 25 of translation).

10. Applicant's arguments regarding the 35 U.S.C. 103 rejections over Chono et al alone and in combination with Ovadia have been fully considered but they are not persuasive.

In response to Applicant's argument that Chono et al fails to teach the limitations of the independent claims, see the above answer to the argument presented for the 35 U.S.C. 102 rejections.

### **Conclusion**

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**



Art Unit: 1772

**ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the


Art Unit: 1772

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB   
March 1, 2004

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

3/2/04